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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/645,959 | 08/22/2003 | Michael Wayne Brown | AUS920010819US2 | 8404 |

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| EXAMINER |
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PATEL, HEMANT SHANTILAL

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| ART UNIT | PAPER NUMBER |
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2614

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
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Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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|------------------------------|-------------------------------|------------------------------|--|
| Office Action Summary | Application No. 10/645,959 | Applicant(s) BROWN ET AL. | |
| | Examiner Hemant Patel | Art Unit 2614 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Applicant Response filed on February 14, 2007 to an Office Action dated November 14, 2006 is entered. Claims 1-32 are pending in this application.

Response to Arguments

2. Applicant's arguments filed February 14, 2007 have been fully considered but they are not persuasive.

3. **Regarding claim 1**, the Applicant argues (Remarks, pg. 16, line 7 from the bottom to line 4 from the bottom) "the IP with SIV is not external to PSTN", and "therefore cannot disclose *an external server* enabled to perform a caller identity authentication service"; (Remarks, pg. 19, ll. 2-3) "Farris's IP with SIV is not a server external to a PSTN". The Examiner respectfully disagrees. As explained in previous Office Action, Farris' IP providing speech verification is external to the central office of a trusted telephone network (PSTN) and the central office brokers connection between the caller and this external IP (Farris, col. 18, ll. 22-col. 20, ll. 49). As shown in Farris Figs. 1, 3, this independent IP is connected to the trusted network (PSTN) thru Integrated Services Digital Network (ISDN) links as well as data network (Internet) with TCP/IP. It was known in the art, that customer premises equipments (CPE), i.e. third party servers providing special services, connected to telephone service provider network (PSTN) using Primary Rate Interface (PRI) of ISDN. These CPEs were not part of the PSTN owned and operated by telephone service provider but they were some external server nodes on the network and were accessible to any other subscriber on

the PSTN. Thus, the IP connected to PSTN is an external server node connected on the network. Moreover, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., IP server not external to PSTN) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

4. **Regarding claim 13**, the Applicant argues (Remarks, pg. 21, ll. 5) "the IP with SIV is not external to PSTN"; (Remarks, pg. 23, ll. 16-17) "Farris's "node of the network," clearly referring to a node of the *same* network, cannot be said to teach an *external* server"; (Remarks, pg. 24, ll. 3) "Farris's IP with SIV is not a server external to a PSTN". The Examiner respectfully disagrees. As explained in previous Office Action, Farris' IP providing speech verification is external to the central office of a trusted telephone network (PSTN) and the central office brokers connection between the caller and this external IP. The IP performs caller identity by caller speech verification and this identity is passed to the terminating office and then to the callee (Farris, col. 18, ll. 22-col. 20, ll. 49; col. 21, ll. 36-col. 22, ll. 51). As shown in Farris Figs. 1, 3, this independent IP is connected to the trusted network (PSTN) thru Integrated Services Digital Network (ISDN) links as well as data network (Internet) with TCP/IP. It was known in the art, that customer premises equipments (CPE), i.e. third party servers providing special services, connected to telephone service provider network (PSTN) using Primary Rate Interface (PRI) of ISDN. These CPEs were not part of the PSTN

owned and operated by telephone service provider but they were some external server nodes on the network and were accessible to any other subscriber on the PSTN. Thus, the IP connected to PSTN is an external server node connected on the network.

Moreover, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., IP server not external to PSTN) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

5. **Regarding claim 31**, the Applicant argues (Remarks, pg. 28, ll. 1-3) "Farris does not disclose "a authentication service accessible via a network external to said trusted telephone network"". The Examiner respectfully disagrees. As explained in previous Office Action, Farris' IP and SCP communicate over via separate network (internet) and provide authentication service that is accessible via a network external to trusted telephone network (Farris, Fig. 1, item 27; col. 19, ll. 18-20; col. 17, ll. 24-30).

6. **Regarding amended claim 32**, the Applicant argues (Remarks, pg. 30, last 2 lines at the bottom) Farris does not disclose an external server that provides authentication services. Refer to above discussion regarding claims 1, 13 and 31 for explanation of an external server providing authentication service.

For the above reasons, the Applicant arguments are not persuasive and for Applicants' convenience, the claim rejections are reproduced here with modifications for amended claims.

Response to Amendment

7. Applicant's arguments with respect to claims 1-32 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-14, 17-20, 23-26, 29-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Farris (US Patent No. 6,122,357).

Regarding claim 1, Farris teaches of a method for specifying telephone services for a particular caller, comprising:

detecting a call initiation condition from an origin device at a trusted telephone network (col. 18, ll. 8-14);

brokering a connection between said origin device and an external server enabled to perform a caller identity authentication service (col. 18, ll. 22-col. 19, ll. 5, switch brokering connection between off hook line and IP); and

responsive to receiving, from said external server, an authenticated caller identity of a caller utilizing said origin device, specifying services available to said caller according to said authenticated caller identity (col. 20, ll. 6-49, IP authenticating caller

and providing virtual ID of authenticated caller which is used to load specific subscriber service profile) (Refer to explanations in Response to Arguments section).

Regarding claim 2, Farris teaches of a method wherein said server is accessible via a network outside said trusted telephone network (Fig. 1, item 23, IP is outside of network and is accessed via T1, SMDI or PRI; col. 11, ll. 10-20, ll. 42-54).

Regarding claim 3, Farris teaches of a method further comprising:
retrieving a caller profile for said authenticated caller identity (col. 20, ll. 6-49, IP authenticating caller and providing virtual ID which is used to load specific subscriber service profile); and

specifying a selection of services from among a plurality of services that are offered for said call according to said caller profile (col. 20, ll. 33-49, variety of services selection based on profile).

Regarding claim 4, Farris teaches of a method wherein said authenticated caller identity is authenticated by a voice utterance of said caller (col. 19, ll. 26-40; col. 19, ll. 65-col. 20, ll. 5).

Regarding claim 5, Farris teaches of a method wherein brokering a connection further comprises:

transmitting a request for said caller identity authentication service via a signal gateway to a network for accessing said external server (col. 19, ll. 16-40, SCP instructing IP);

transferring a prompt for a voice utterance, received from said external server via a media gateway, to said origin device (col. 19, ll. 41-43);

transferring a voice utterance by said caller through said media gateway to said network for accessing said external server (col. 19, ll. 43-46); and

receiving said authenticated caller identity via said signal gateway at said trusted telephone network (col. 20, ll. 14-22).

Regarding claim 6, Farris teaches of a method wherein brokering a connection further comprises:

brokering a secure connection between said trusted telephone network and said external server (Fig. 1, SCP, STP, SSP and IP are connected by SS7, T1, PRI, SMDI etc. which are secure telephony networks as is known in the art).

Regarding claim 7, it recites a system with a network and means performing functions substantially similar to the method as claimed in claim 1. Farris teaches of such a system (Figs. 1, 2, 3). Refer to rejection for claim 1.

Regarding claim 8, refer to rejections for claim 2 and claim 7.

Regarding claim 9, refer to rejections for claim 3 and claim 7.

Regarding claim 10, refer to rejections for claim 4 and claim 7.

Regarding claim 11, refer to rejections for claim 5 and claim 7.

Regarding claim 12, it recites a computer program product specifying a recording medium with means recorded on it for performing functions substantially similar to the method as claimed in claim 1. Farris teaches of such a system using computers and software as is well known in the art (Fig. 1, SCP, STP, SSP, IP etc.; Fig. 2, Items 53, 55; Fig. 3, item 23; col. 16, ll. 16-20). Refer to rejection for claim 1.

Regarding claim 13, Farris teaches of a method for informing a callee of a caller identity, comprising:

detecting a call initiation condition from an origin device at a trusted telephone network (col. 18, ll. 8-14);

brokering a connection between said origin device and an external server enabled to perform a caller identity authentication service (col. 18, ll. 22-col. 19, ll. 5, switch brokering connection between off hook line and IP); and

responsive to receiving, from said external server, an authenticated caller identity of a caller utilizing said origin device, transferring said authenticated caller identity to a destination device, such that a callee receiving said call at said destination device is provided with an identity of a party originating said call (col. 20, ll. 6-32, IP authenticating caller and providing virtual ID; col. 21, ll. 36-col. 22, ll. 28, terminating office receives and delivers caller ID to called party line) (Refer to explanations in Response to Arguments section).

Regarding claims 14, 17, Farris teaches of a method further comprising:

filtering content of said authenticated caller identity before transfer to said destination device (col. 22, ll. 41-51, terminating office receives name and number of caller but delivers only partial data of name).

Regarding claim 18, Farris teaches of IP initiating a recording of a call by the central office as a call using default profile providing only E911 service and flat rate local calling, the call being processed as a normal call for caller ID purposes (col. 25, ll. 5-32).

Regarding claim 19, it recites a system with a network and means performing functions substantially similar to the method as claimed in claim 13. Farris teaches of such a system (Figs. 1, 2, 3). Refer to rejection for claim 13.

Regarding claim 20, refer to rejections for claim 14 and claim 19.

Regarding claim 23, refer to rejections for claim 17 and claim 20.

Regarding claim 24, refer to rejections for claim 18 and claim 19.

Regarding claim 25, it recites a computer program product specifying a recording medium with means recorded on it for performing functions substantially similar to the method as claimed in claim 19. Farris teaches of such a system using computers and software as is well known in the art (Fig. 1, SCP, STP, SSP, IP etc.; Fig. 2, Items 53, 55; Fig. 3, item 23; col. 16, ll. 16-20). Refer to rejection for claim 19.

Regarding claim 26, refer to rejections for claim 20 and claim 25.

Regarding claim 29, refer to rejections for claim 23 and claim 26.

Regarding claim 30, refer to rejections for claim 24 and claim 25.

Regarding claim 31, Farris teaches of a method for controlling caller identification, comprising:

receiving, from a trusted telephone network, an authenticated caller identity for a caller at a telephony device (col. 18, ll. 22-col. 20, ll. 32; col. 21, ll. 36-col. 22, ll. 18), wherein said caller identity is authenticated at a authentication service accessible via a network external to said trusted telephone network (Fig. 1, item 23, IP Remote; col. 11, ll. 42-54), wherein said trusted telephone network initiates said authentication service (col. 18, ll. 22-col. 20, ll. 49); and

controlling output of said authenticated caller identity from said telephony device, such that an individual with access to said telephony device is informed of the identity of said caller (col. 21, ll. 36-col. 22, ll. 51) (Refer to explanations in Response to Arguments section).

Regarding claim 32, Farris teaches of a method comprising:

receiving, at a telephony device, a secure communication channel via a trusted telephone network to an authentication service, wherein said trusted telephone network initiates said authentication service provided by an external server (col. 18, ll. 7-col. 19, ll. 47; CO initiating authentication service performed by external server IP wherein SCP and IP communicate over external network i.e. Internet, also col. 17, ll. 24-30; and col. 20, ll. 6-32, IP returns authenticated identity); and

facilitating, from said telephony device, communications between said authentication service and a caller, such that said authentication service is enabled to authenticate an identity of said caller (col. 19, ll. 16-col. 20, ll. 32) (Refer to explanations in Response to Arguments section).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2614

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 15-16, 21-22, 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farris as applied to claims 14, 20, 26 above, and further in view of Rozenblit (US Patent No. 5,832,072).

Regarding claim 15, Farris does not teach of filtering caller identity according to caller identity preferences.

However, in the same field of endeavor, Rozenblit teaches of filtering (blocking) content of caller identity according preference associated with calling identity by the caller (caller selected blocking option) (col. 1, ll. 30-33).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Farris to include blocking of the caller identity as taught by Rozenblit in order to protect the abused spouse from abuser (Rozenblit, col. 1, ll. 27-30).

Regarding claim 16, Farris does not teach of filtering caller identity according to callee identity.

However, in the same field of endeavor, Rozenblit teaches of filtering (replacing) caller number with callee assigned name (callee preference) (col. 7, ll. 11-15).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Farris to replace caller identity number with assigned name as taught by Rozenblit in order to improve "calling line information delivery technique which preserves the rights of the caller without unduly restricting the flow of useful information to the called party" (Rozenblit, col. 1, ll. 44-46).

Regarding claim 21, refer to rejections for claim 15 and claim 20.

Regarding claim 22, refer to rejections for claim 16 and claim 20.

Regarding claim 27, refer to rejections for claim 21 and claim 26.

Regarding claim 28, refer to rejections for claim 22 and claim 26.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

| | |
|-------------------------|-------------|
| US Patent No. 5,566,229 | Hou |
| US Patent No. 5,978,450 | McAllister |
| US Patent No. 6,205,204 | Morganstein |

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hemant Patel whose telephone number is 571-272-8620. The examiner can normally be reached on 8:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 571-272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2614

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hemant Patel
Examiner
Art Unit 2614

HSP

H. Patel


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